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10/614,399	07/03/2003	Louis Brown Abrams	4811-18	5901
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SHERIDAN ROSS PC 1560 BROADWAY SUITE 1200 DENVER, CO 80202			EXAMINER JUSKA, CHERYL ANN	
			ART UNIT 1771	PAPER NUMBER

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/614,399

Applicant(s)

ABRAMS, LOUIS BROWN

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 27, 29-47 and 49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 27 and 32-47 is/are rejected.
- 7) ☒ Claim(s) 29-31 and 49 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 04/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed April 10, 2006, has been entered. Claims 1-26, 28, and 48 are cancelled and new claim 49 has been added. The specification and claims 27, 30, 35, and 43 have been amended as requested. Thus, the pending claims are 27, 29-47, and 49.
2. Said amendment is sufficient to withdraw the 112, 2<sup>nd</sup> rejection set forth in section 6 of the last Office Action. Additionally, said amendment is sufficient to withdraw the 112, 1<sup>st</sup> rejections set forth in sections 10 and 12 of the last Office Action. Furthermore, the 112, 1<sup>st</sup> rejection of claims 34 and 37 as set forth in sections 11 and 13 of the last Office Action are hereby withdrawn due to applicant's arguments. Specifically, the subject matter of claim 34 appears in originally filed claim 8 and, hence, is not new matter. Also, the subject matter of claim 37 is supported by the specification, page 27, lines 12-14.
3. Said amendment is sufficient to withdraw the double patenting rejection set forth in section 3 of the last Office Action.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re*

Art Unit: 1771

*Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 27 and 32-47 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 4-41 and 45-65 of copending Application No. 10/614,340. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims overlap or are obvious variants thereof.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Objections***

6. Claims 29-31 and 49 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Said claims depend from claim 28 which has been cancelled by amendment. As such, claims 29-31 and 49 are not further examined on the merits.

7. Claim 27 is objected to because the amendment to the claim changes the scope of the claim so that it does not match that of the preamble. Specifically, the claim has been amended to include steps of *forming a molded article* with the mold insert. As such, the preamble limitation

of “a method of *forming a mold insert* for molding an article” is no longer commensurate in scope with the claim.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 46 stands indefinite as set forth in section 7 of the last Office Action. Specifically, claim 46 is indefinite because of the limitation wherein “the backing film is nonwoven.” Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “nonwoven” is used by the claim and the specification to be a film-like material (i.e., “not a textile or a fabric”) (specification, page 22, lines 10-13), while the accepted meaning of nonwoven is limited to textile materials (i.e., comprising fibers), such as fabrics. The term is indefinite because the specification does not clearly redefine the term. Due to said indefiniteness the claim is not further examined on the merits.

10. Claim 35 is indefinite for the recitation of “the flocked regions...are not a fabric.” There is a lack of antecedent basis for “flocked regions.”

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

Art Unit: 1771

pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 35 limits the flocked regions to not being a fabric. While the specification limits the backing film to being a nonwoven and not a textile or a fabric, the specification does not teach the negative limitation that the flocked regions are not a fabric. Therefore, claim 35 is rejected as containing new matter.

### *Response to Arguments*

13. Applicant traverses the rejection of claim 46 by asserting “It appears the Examiner is incorrectly interpreting the sentence stating that in one embodiment, ‘the backing film is in the form of a cast or extruded film’ to be inextricably linked to its preceding sentence (which states that the backing film is preferably nonwoven and neither a textile nor a fabric).” (Amendment, page 11, 2<sup>nd</sup> paragraph). The examiner respectfully disagrees. In fact, the second sentence (i.e., “the backing film is in the form of a cast or extruded film”) was not even considered in making the rejection. Rather, the rejection is based upon the first sentence alone. Specifically, the phrase “the backing film is preferably nonwoven” is contrary to the accepted definitions of both film and nonwoven. A nonwoven is inherently a fabric or a textile. A fabric or textile is not a film and a film is not a textile or fabric. While textiles and fabrics, by definition, comprise fibers or filaments, films do not include fibers or filaments. Thus, applicant’s language in the

specification and the claims are contrary to the accepted meanings in the art. Therefore, the 112, 2<sup>nd</sup> rejection of claim 46 stands.

*Claim Rejections - 35 USC § 103*

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 27 and 32-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 56-058824 issued to Kondo et al. in view of JP 58-062027 issued to Moriyama et al., US 4,810,549 issued to Abrams et al., and US 6,646,022 issued to Okazaki et al.

Kondo teaches a molded article comprising a (protective) film 2, a decorative layer 3, an adhesive layer 4, a resin backing material 5, and a molded resin (abstract and Figures 1, 2, and 5). Kondo teaches the resin of the backing material is the same as the molding resin. The reference is silent with respect to the resin backing layer 5 or adhesive layer 4 being fabric. Figure 5 shows a molded three-dimensional article comprising a mold insert of the decorative layer, adhesive layer, and resin backing layer and the resin injected into the mold.

Thus, Kondo teaches the invention of claim 27 with the exception of (a) the decorative layer is a flock transfer, (b) the adhesive layer is a thermosetting adhesive, (c) the mold insert being formed into a three-dimensional shape prior to placement of said mold insert into a mold, and (d) the thermosetting adhesive being thermoset before introduction (i.e., injection) of the resin into the mold. However, it is asserted the claim is obvious over the cited Kondo reference.

With respect to the decorative layer comprising flock fibers, while Kondo does not explicitly teach flocked fibers as suitable for said decorative layer, it would have been readily obvious to one skilled in the art to select flock. For example, Moriyama teaches a foam molded article having a decorative surface layer comprised of flock fibers (translation, claim 1). Motivation to do so would be that flock is known in the art as a suitable decorative layer for molded articles, wherein said flock can produce an aesthetically pleasing, soft and plush texture to the molded article.

Kondo and Moriyama fail to teach the flocked surface is produced by a flock transfer rather than by direct application. However, flock transfers are common to the art. For example, Abrams teaches a flock transfer comprising a paper release substrate, a release adhesive, flock fibers, a binder adhesive, a hot melt adhesive, and flocking substrate (abstract, col. 2, lines 34-68, and Figures 1 and 2). Thus, it would have been readily obvious to one skilled in the art to employ a flock transfer rather than direct flocking in order to produce an aesthetically pleasing flocked surface (e.g., multicolored or graphic designs). Flock transfers are typically employed when the substrate to be flocked is not necessarily suitable for electrostatic flocking (e.g., shape, size, or type of material) or in customized applications (e.g., decorative), many of which have patterned flocked areas. Note in the patterned decorative flock transfers the permanent adhesive is typically applied discontinuously to match the pattern of the flock.

While Kondo fails to explicitly teach the composition of the adhesive layer 4, it is argued that it would have been readily obvious to one skilled in the art to select either a thermoset adhesive. A thermoset adhesive would produce a very secure bond between the decorative material 3 and the backing material 5. It has been held to be within the general skill of a worker



Art Unit: 1771

in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416.

Kondo, Moriyama, and Abrams fail to teach pre-shaping the mold insert to fit the shape of the mold. However, this step is well known in the art as evidenced by the cited Okazaki reference. Specifically, Okazaki teaches shaping a decorative mold insert to follow the shape of the mold prior to inserting and arranging the insert in the mold (col. 21, lines 47-67). Thus, it would have been readily obvious to one of ordinary skill in the art to pre-shape the mold insert of Kondo in order to provide a more complex molded article having a decorative flock surface over the entire surface of said article rather than just an inlaid portion thereof (see Kondo, Figure 5).

Additionally, it is noted that upon employing a thermosetting adhesive, said adhesive would be thermoset upon shaping the mold insert before placing in said mold. Therefore, claims 27, 32, 33, 35, and 47 are rejected.

With respect to claim 34, the limitations that the adhesive layer and backing film are cast or extruded are not given patentable weight at this time since said limitations amount to an article limitations in a method claim. The method of forming a cast or extruded film or adhesive layer is not positively recited as a method step. Therefore, claim 34 is also rejected.

Regarding claims 36 and 37, it would have been readily obvious to one of ordinary skill in the art to produce a continuous length of backing film wherein a plurality of mold inserts are cut therefrom in order to increase mass production rates and efficiency.

The cited prior art fails to teach the claimed PCT polyester. However, it would have been readily obvious to one of ordinary skill in the art to select a polyester having the claimed formula (i.e., poly(cyclohexylene-dimethylene terephthalate or PCT) since it has been held to be

Art Unit: 1771

within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. PCT is known to have good resiliency and thermal stability. As such, it would have been obvious to select said PCT for the polyester of the prior art invention. Additionally, these features of the flock do not manipulatively effect the claimed process steps. Therefore, claims 38 and 39 are rejected.

Regarding claims 40-43, absent a showing of unexpected results, the recited flock length, flock titre or denier, and flock density are not seen as being patentably distinguishable from the prior art. The presently claimed ranges are not novel to the art of flocking. Additionally, these features of the flock do not manipulatively effect the claimed process steps. Therefore, claims 40-43 are rejected.

With respect to claims 44 and 45, applicant is hereby given Official Notice that is well known to treat flocked substrates with an antimicrobial agent. Thus, it would have been readily obvious over the cited prior art to add an antimicrobial composition to the flock in order to reduce microbial activity on the flocked substrate. Therefore, claims 44 and 45 are also rejected.

### ***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1771

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CHERYL A. JUSKA  
PRIMARY EXAMINER

cj  
June 27, 2006